

REMARKS

The Office Action dated April 22, 2004 has been considered. Claims 1 and 4-15 remain pending in the application. Reconsideration and allowance of the application is respectfully requested.

Claims 1, 10, 11, and 15 are amended to include the limitations of, or limitations similar to, now-canceled Claims 2 and 3.

Applicant traverses the rejection of claims 1, 10, 11, 14, and 15 under 35 USC §102(e) as being anticipated by US patent number 6,542,729 to Chmaytelli et al. ("Chmaytelli"). However, the rejection is now moot in view of the amendments to claims 1, 10, 11, and 15.

Applicant traverses the rejection of claims 6, 12, and 13 under 35 USC §103(a) as being unpatentable over Chmaytelli in view of US patent number 6,195,568 to Irvin. However, the rejection is now moot in view of the amendments to claims 1 and 11.

Applicant traverses the rejection of claim 7 under 35 USC §103(a) as being unpatentable over Chmaytelli in view of US patent number 6,583,714 to Gabou et al. ("Gabou"). However, the rejection is now moot in view of the amendment to claim 1.

The Office Action does not establish that claims 2, 3, 5 and 8 are unpatentable under 35 USC §103(a) over Chmaytelli (“Chmaytelli”) in view of US patent number 5,995,824 to Whitfield (“Whitfield”). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for combining the teachings of Whitfield with teachings of Chmaytelli, and fails to show that the combination could be made with a reasonable likelihood of success.

As to claim 2 (the limitations of which are now in amended claim 1), the alleged motivation for modifying Chmaytelli with Whitfield is improper. Claim 2 includes limitations of storing sound data for subsequent playback. The Office Action alleges that it would have been obvious to “modify Chmaytelli with the third data set taught by Whitfield ... [which] allows for conversations to be recorded as suggested by Whitfield.” This alleged motivation is improper because it merely restates the limitations of the claim as the motivation. The motivation must come from the prior art, not the claim itself. Furthermore, Chmaytelli’s system is directed to minimizing fraudulent use of a mobile telephone, and there is no evidence of a benefit to Chmaytelli to also be able to record. Therefore, the alleged motivation for modifying Chmaytelli with Whitfield is improper.

As to claim 3 (the limitations of which are now in amended claim 1), the Office Action does not show that the Chmaytelli-Whitfield combination shows or suggests all the limitations, and the alleged motivation for combining the references is improper. The Office Action fails to establish that the prior art suggests the limitations of comparing the third data set to each of a plurality of recorder-command data sets, each of the recorder-command data sets being associated with a sound recorder function performed by the portable information appliance, and performing the sound recorder function associated with a recorder-command data set that matches the third data set. The Official Notice taken by the Office Action of these limitations is improper.

MPEP 2144.03 (B) provides that the examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. The stated Official Notice is improper because no specific factual findings predicated on sound technical reasoning are presented. These limitations taken as a whole are not thought to be well-known in the art, and a citation to specific prior art thought to suggest these limitations is respectfully requested if the rejection is maintained.

The alleged motivation for modifying the Chmaytelli-Whitfield reference is improper. The Office Action alleges that it would have been obvious “to further modify the combination of Chmaytelli and Whitfield with recorder-command data sets ... to allow conversation-recording functions to be initiated hands free.” This alleged motivation is improper because it merely restates what the claim limitations accomplish. This alleged motivation for modifying the Chmaytelli-Whitfield combination is improper because no prior art evidence is provided in support thereof.

Claim 5 depends from amended claim 1 (which includes the limitations of now-canceled claims 2 and 3). Thus, claim 5 is patentable over the Chmaytelli-Whitfield combination for at least the reasons set forth above.

The Office Action does not establish that Claim 8 is unpatentable over the Chmaytelli-Whitfield combination because no cited teaching of Whitfield suggests the program-button mode. Under the limitations of claim 8, buttons of the portable information appliance may be programmed by a user. The cited teachings of Whitfield’s col. 3 do not suggest these limitations.

Whitfield’s col. 3 describes a RECORD key for beginning and ending recording and a function key for playing back recordings. There is no apparent suggestion that Whitfield’s keys are user-programmable, nor does the Office Action cite any specific ones of Whitfield’s elements as suggesting these limitations. Therefore, the Office Action does not establish that Whitfield suggests the limitations of claim 8.

The alleged motivation for modifying Chmaytelli with Whitfield states that the modification would allow conversations to be recorded. This alleged motivation does not relate to user-programmable keys, and is therefore improper. Furthermore, the alleged motivation is conclusory.

The rejection of claims 2, 3, 5, and 8 (as may be applied to amended claims 1, 11, and 15) over the Chmaytelli-Whitfield combination should be withdrawn because the Office Action fails to show all the limitations are suggested by the combination, fails to provide a proper motivation for combining the references, and fails to show that the combination could be made with a reasonable likelihood of success.

The Office Action does not establish that claims 4 and 9 are unpatentable under 35 USC §103(a) over the Chmaytelli-Whitfield combination in further view of Gabou. The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the Chmaytelli-Whitfield combination with teachings of Gabou, and fails to show that the modification could be made with a reasonable likelihood of success.

Claims 4 and 9 include limitations of, after a period of inactivity, returning the portable information appliance to the standby mode and placing the appliance in a power-saving mode, respectively. Gabou's col. 4, as cited by the Office Action, does not suggest performing any particular action after a period of inactivity.

Gabou's col. 4 suggests switching a terminal to a secure mode after a predetermined time delay. However, there is no apparent suggestion that Gabou's time delay relates to inactivity, nor is there any apparent explanation of how the time delay is measured. Therefore, the Office Action does not establish that Gabou suggests, after a period of inactivity returning the appliance to the standby mode as set forth in claim 4.

The alleged motivation for modifying the Chmaytelli-Whitfield combination with Gabou is improper. The alleged motivation states that the modification would enable "users to avoid entering their code every time for several outgoing calls." Not only is this alleged motivation conclusory (no evidence is provided), but the conclusion teaches away from the limitations associated with the claimed stand-by mode. The claimed standby mode controls access to the functions of the appliance by requiring matching of the previously recorded sound to a sound captured in standby mode. The alleged motivation says that Gabou's teachings remove the access control, which is at odds with the claimed standby mode which enforces access control. Therefore, the alleged motivation is improper.

Gabou's col. 4 does not suggest the limitations of claim 9 in which, after a period of inactivity placing the appliance in a power-saving mode. As with claim 4, there is no apparent suggestion of performing any action after a period of inactivity. Further explanation is requested if the rejection is maintained. Otherwise, the rejection is improper and should be withdrawn.

Withdrawal of the rejections and reconsideration of the claims are respectfully requested in view of the remarks set forth above.

No extension of time is believed to be necessary for consideration of this response. However, if an extension of time is required, please consider this a petition for a sufficient number of months for consideration of this response. If there are any additional fees in connection with this response, please charge Deposit Account No. 50-0996 (HPCO.045PA).

Respectfully submitted,

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